

U.S. Serial No. 10/801,350
Amendment Dated November 10, 2005
Response To Office Action Dated August 10, 2005

REMARKS

The pending application was filed on March 16, 2004 with claims 1-35. The Examiner issued a Restriction Requirement dated November 18, 2004 identifying claims 1-30 as Group 1 and claims 31-35 as Group 2. A response was filed on December 6, 2004 in which claims 1-30 were elected. The Examiner issued a Non-Final Office Action dated February 22, 2005. A Response was filed May 23, 2005. The Examiner issued a Final Office Action dated August 10, 2005 in which all pending claims 1-30 were rejected. The Examiner and the Undersigned Representative conducted a telephonic interview on November 1, 2005 in which the pending claims were discussed.

Claims 1-30 were pending in the patent application. Claims 31-35 have been previously withdrawn. Claims 1 and 17 have been amended, and claims 16 and 30 have been canceled without prejudice. In view of the arguments set forth below, claims 1-15 and 17-29 are pending and allowable, and the Examiner is respectfully requested to withdraw the rejections and issue a timely Notice of Allowance.

L SUBSTANCE OF THE INTERVIEW

The Examiner and the Undersigned Representative conducted a telephonic interview on November 1, 2005 in which the pending claims were discussed. The Undersigned Representative and the Examiner discussed United States Published Patent Application

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Number 2002/0078619 to *Hurtle, Jr.* and discussed the differences between the tube lure of *Hurtle* and the claimed lure of the invention. No agreement was reached.

II. SPECIFICATION

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter, specifically, "the shank receiving cavity." Claim 1 has been amended to recite a "shank containing region" as described in the specification. Thus, the Examiner is respectfully requested to withdraw the rejection.

III. REJECTION OF CLAIMS 1-30 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 1-5, 7, 10, 11, 14-16 under 35 U.S.C. §103(a) as being unpatentable over United States Published Patent No. 2002/0078619 to *Hurtle, Jr.* in view of United States Patent No. 5,220,743 to *McClellan*. Specifically, the Examiner stated that *Hurtle* discloses a body having at least one cavity in a midsection of the body and at least one opening in a top surface of the body. The Examiner also stated that *McClellan* discloses a fishing lure having a weight mounted on a fishing hook closer to the throat of the hook than the line receiving portion of the hook. The Examiner stated that it would have been obvious to provide *Hurtle* with a weight mounted hook as shown by *McClellan* to change the action of the lure in the water. However, the Examiner admitted that the combination of *Hurtle* as modified by *McClellan* does not show the midpoint of the weight positioned at a mid-section

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of the body; yet, the Examiner concluded that it would have been obvious to position the midpoint of the weight at a mid-section of the body since the change in location of parts is obvious.

Claim 1 has been amended to state in relevant part "wherein the weight coupled to the hook is positioned in the at least one cavity in the body such that a midpoint of the weight is proximate to a midpoint of the lure such that a longitudinal axis of the lure is generally horizontal when the lure is in water." In stark contrast, *Hurtle* does not disclose a weight positioned in a cavity in a lure such that a longitudinal axis of the lure is generally horizontal when the lure is in water. Rather, *Hurtle* discloses a tube lure having a cavity extending through the body to the nose of the body. The tube lure disclosed in *Hurtle* is a conventional tube lure in which the head of the lure is weighted and dives headfirst to the bottom. Such action is vastly different from the claimed structure in amended claim 1. Amended claim 1 requires that a weight be positioned "proximate to a midpoint of the lure such that a longitudinal axis of the lure is generally horizontal when the lure is in water." Thus, the claimed structure causes the lure to maintain a generally level attitude in water "such that a longitudinal axis of the lure is generally horizontal when the lure is in water." The action produced by the claimed lure is very different from the tube lure of *Hurtle*. Thus, the positioning of the weight is not simply "a change in location."

Furthermore, to establish a *prima facie* case of obviousness, three basic criteria must be met. MPEP 2142 (2100-128). The three basic criteria include: (1) there must be some

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suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP 2142 (2100-128). Neither *Hurtle* nor *McClellan* provides any suggestion or motivation to modify the references or to combine reference teachings. In addition, there is no suggestion or motivation in the knowledge generally available to one of ordinary skill in the art to combine these references. *Hurtle* discloses a tube lure designed to dive headfirst, and *McClellan* discloses a jerk bait with a weight attached to the shank of the hook that is configured to enhance the erratic action of the jerk bait when retrieved through water. The embodiments disclosed in *Hurtle* and *McClellan* produce drastically different actions in a lure in water. The combination of *Hurtle* and *McClellan* does not yield the action produced by the claimed invention. A lure that dives headfirst combined with a lure having erratic side to side action does not yield a lure with a generally stable action. Thus, there is no motivation to combine the lures of *Hurtle* and *McClellan*. Therefore, for at least these reasons, the claimed invention is not rendered obvious by the combination of *Hurtle* and *McClellan*, and the Examiner is respectfully requested to withdraw the rejection.

The Examiner rejected claims 6-9 under 35 U.S.C. §103(a) as being unpatentable over *Hurtle* in view of *McClellan* further in view of United States Patent No. 5,070,639 to *Pippert*. The Examiner stated that *Hurtle* and *McClellan* disclose fishing lures as claimed,

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but the Examiner admitted that neither *Hurtle* nor *McClellan* disclose a body saving device coupled to the base. The Examiner stated that *Pippert* discloses a fishing lure having a body saving device coupled to the base. The Examiner concluded that it would have been obvious to provide the fishing lure of *Hurtle* as modified by *McClellan* with a body saving device as shown by *Pippert*. The Examiner also stated that while *Pippert* only discloses a single protrusion that multiple protrusions would have been obvious.

Paragraph 38 of the specification provides that "the body saving device 62 may be formed from one or more protrusions 62 for preventing the weight 34 from cutting through the body 12 when the body 12 impacts a piling, rock pile, limb, or other resilient structure." (emphasis added). In sharp contrast, the protrusion disclosed in *Pippert* is defined as a barb in *Pippert*. A barb would not act as a body saving device in a lure. Rather, a barb would damage a lure upon impact with a piling, rock pile, limb, or other resilient structure. Thus, the combination of *Pippert* with *Hurtle* and *McClellan* does not render the claims 6-9 obvious, and the Examiner is respectfully requested to withdraw the rejection.

The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over *Hurtle* in view of *McClellan* further in view of United States Patent No. 6,240,672 to *Huppert*. The Examiner stated that *Hurtle* and *McClellan* disclose the claimed invention but do not show a plurality of ribs extending around the body. The Examiner stated that *Huppert* discloses a fishing lure having a plurality of ribs extending around the body. The Examiner

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concluded that it would have been obvious to provide the lure of *Hurtle* as modified by *McClellan* with a plurality of ribs.

Claim 13 depends directly from claim 1, which is allowable for the reasons previously set forth. Thus, claim 13 is allowable, and the Examiner is respectfully requested to withdraw the rejection.

The Examiner rejected claims 12, 17-22, 27, 28, 29, and 30 under 35 U.S.C. §103(a) as being unpatentable over *Hurtle* in view of *McClellan* and other prior art. The Examiner stated that *Hurtle* as modified by *McClellan* disclose the claimed invention, but the Examiner admitted that neither *Hurtle* nor *McClellan* discloses a plurality of legs extending from the head. The Examiner concluded that it would have been obvious to provide the lure of *Hurtle* as modified by *McClellan* with a plurality of legs as shown by the admitted prior art of figures 1-2 for the purposes of making the lure resemble a shrimp.

Claim 17 of the pending application is directed in part to "an elongated body configured to resemble a shrimp and having at least one cavity in a midsection of the body, a head, a tail, and a plurality of legs extending from the head." In addition, claim 12 states "wherein the body includes a head at a first end, a tail at a second end generally opposite to the first end, and at least one set of legs extending from the head." In contrast, neither *Hurtle* nor *McClellan* discloses a lure having a body configured to resemble a shrimp. Furthermore, there is no motivation disclosed in *Hurtle* or *McClellan* to combine the elements disclosed in these references with a lure resembling a shrimp. Such a conclusion is impermissible

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hindsight. Moreover, the headfirst diving action of the tube lure disclosed in *Hurtle* combined with the erratic side to side action exhibited by *McClellan* does not render the neutral attitude of the claimed shrimp. Claim 17 has been amended and states "wherein the weight coupled to the hook is positioned in the at least one cavity in the body such that a midpoint of the weight is proximate to a midpoint of the lure such that a longitudinal axis of the lure is generally horizontal when the lure is in water to resemble the natural attitude of a shrimp." Thus, neither *Hurtle* nor *McClellan* discloses a lure that is positioned "generally horizontal when the lure is in water to resemble the natural attitude of a shrimp," as claimed in claim 17. A conclusion that a combination of the elements disclosed in *Hurtle* with elements disclosed in *McClellan* renders the claimed invention and is impermissible hindsight. Thus, for at least these reasons, claim 12 and 17 and those claims depending from claim 17 are allowable, and the Examiner is respectfully requested to withdraw the rejection.

Claims 23-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Hurtle* in view of *McClellan* and further in view of other prior art and *Pippert*. The Examiner stated that it would have been obvious to provide the lure of *Hurtle* as modified by *McClellan* and prior art with a body saving device shown in *Pippert*.

Paragraph 38 of the specification provides that "the body saving device 62 may be formed from one or more protrusions 62 for preventing the weight 34 from cutting through the body 12 when the body 12 impacts a piling, rock pile, limb, or other resilient structure." In sharp contrast, the protrusion disclosed in *Pippert* is defined as a barb in *Pippert*. A barb

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would not act as a body saving device in a lure. Rather, a barb would damage a lure upon impact with a piling, rock pile, limb, or other resilient structure. Thus, the combination of *Pippert* with *Hurtle* and *McClellan* does not render the claims 23-26 obvious. Furthermore, claims 23-26 depend from claim 17, which is allowable for the reasons previously set forth. Thus, claims 23-26 are allowable, and the Examiner is respectfully requested to withdraw the rejection.

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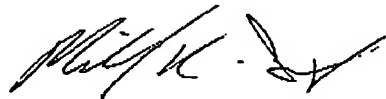
CONCLUSION

For at least the reasons given above, claims 1-15 and 17-29 define patentable subject matter and are thus allowable. The undersigned representative thanks the Examiner for examining this application.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

No fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,



Michael K. Dixon
Reg. No. 46,665
AKERMAN SENTERFITT
222 Lakeview Avenue, Suite 400
West Palm Beach, Florida 33401-6183
(561) 653-5000

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